

**REMARKS**

The Applicants respectfully request reconsideration and allowance of Claims 1-22 in view of the following arguments and the amendments presented above.

**INTERVIEW SUMMARY**

The Applicants appreciate the telephone interview conducted May 24, 2004, between Examiner Nguyen, Primary Examiner Amsbury, and the undersigned attorney. In the interview the undersigned attorney summarized the arguments presented below, in particular, emphasizing the claim amendments and the fundamental distinctions between the prioritization disclosed in U.S. patent 6,345,308 (the "308 patent") and the prioritization required in the present claims. The distinction between the "client device" and the "user initiating the sync session request" as set out in Applicants' claim 1 was also discussed. It was agreed that the Applicants would submit amendments to the independent claims along the lines set out above, however, no agreement was reached as to the allowability of the claims.

**STATUS OF THE CLAIMS**

The present application was filed with claims 1-22. Each of the independent claims, claims 1, 7, and 14 is amended above to clarify the nature of the prioritization schemes employed in the present invention. In particular, claims 1, 7, and 14 are amended to include language defining the referenced "prioritization scheme." Since the meaning of the expression "prioritization scheme" now set out in the claims is apparent from the disclosure in the present

1 application, the Applicants believe that these amendments are not further limiting, but merely  
2 clarify the intended scope of the claims. Claim 3 is amended above to address a further  
3 informality. The amendment to claim 3 does not change the scope of the claim. Claims 1-22  
4 remain pending in this application.

5  
6 CLAIMS 1-22 ARE NOT OBVIOUS OVER THE CITED PRIOR ART

7 The Examiner rejected claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over  
8 U.S. Patent No. 6,345,308 to Abe, et al. ("the 308 patent"). The Applicants respectfully submit  
9 that the claims are not obvious over this reference on the ground that the 308 patent does not  
10 teach or suggest each element required in the respective claims.

11  
12 The 308 Patent

13 The 308 patent is directed to a system for addressing synchronization problems that may  
14 arise in systems having a server that stores data to be used by numerous different network  
15 computers and where one or more of the network computers are mobile and lose communications  
16 with the server during mobile operations. In particular, the 308 patent addresses the problem that  
17 may occur in such a system where the mobile network computer obtains a replica of data from  
18 the server and then conducts mobile operations in which the data is modified at the mobile  
19 computer while the original data at the server is also independently modified. In this situation,  
20 once the mobile computer reestablishes communications with the server, there arises an issue as  
21 to whether the server data is to be updated with the modified data from the mobile operations and

1 an issue as to the fate of the data modifications at the server which occurred during the mobile  
2 operations.

3 To help resolve these issues, the 308 patent discloses producing a synchronization list that  
4 identifies the replica resources or data transferred to the mobile computer prior to the loss of a  
5 communications link between the server and the mobile computer. This synchronization list is  
6 stored at the server and a replica of the list is also stored at the mobile computer. As data  
7 identified in the synchronization list at the server is modified, the synchronization list at the  
8 server is itself modified. When the mobile computer reestablishes communications with the  
9 server and attempts to send its updated data back to the server, the system disclosed in the 308  
10 patent employs the server synchronization list from the server and the replica list at the mobile  
11 computer to decide how to synchronize the data at the server and the data at the mobile  
12 computer. The 308 patent discloses using priority options in the synchronization lists which  
13 define priority rules for use in synchronizing the data at the server and the data at the mobile  
14 computer. That is, the priorities described in the 308 patent are priorities used during  
15 synchronization between the server and the mobile computer. The priorities disclosed in the 308  
16 patent do not relate to prioritization of data at the server for producing a prioritized data set that  
17 can then be used in conducting a synchronization session with the mobile computer as in the  
18 present invention.

19  
20 The 308 Patent Fails to Teach or Suggest all of the Elements Set Out in the Claims

21 In forming the obviousness rejection in view of the 308 patent the Examiner likened the  
22 synchronization list disclosed in the 308 patent to the synchronization scheme required in the

1 Applicants' claims. The Examiner also referred to the priorities disclosed at Figure 8 and  
2 discussed at Col. 11, lines 60-65 of the 308 patent.

3 Element (a) of Applicants' claim 1 as amended above requires,

4 "in response to a sync session request designating a client device, reading a  
5 selected prioritization scheme associated with a user initiating the sync session  
6 request, **the selected prioritization scheme comprising a scheme of**  
7 **prioritization among data included in a set of objective data remote from the**  
8 **client device to produce a prioritized data set"** (emphasis added).

9 This meaning of "prioritization scheme" set out in claim 1 is illustrated in Figure 1 where the  
10 data store storage device 12 is remote from the client device 42, 44, 45, and 46. The  
11 prioritization of data from the data store 12 remote from the client device is described in the  
12 present specification beginning at the bottom of page 20 with reference to Figure 4 through the  
13 bottom of page 25. This requirement for the synchronization scheme read at element (a) of  
14 Applicants' claim 1 is in stark contrast to the synchronization list described in the 308 patent.  
15 Rather than a scheme of prioritization among data at the server, the synchronization list disclosed  
16 in the 308 patent is merely a list of resources that have been replicated on the mobile network  
17 computer. The priorities shown in Figure 8 of the 308 patent and described at the bottom on Col.  
18 11 of that patent are priorities between data or resources at the server and data or resources at the  
19 network computer. The synchronization list and priority option disclosed in the 308 patent is not  
20 a scheme for prioritizing data remote from a client device. Thus, the 308 patent does not teach or  
21 suggest the step of reading a prioritization scheme as required at element (a) of Applicants' claim  
22 1.

1 Because the 308 patent does not teach or suggest element (a) of Applicants' claim 1, the  
2 Applicants respectfully submit that claim 1 is not obvious in view of the 308 patent and is  
3 entitled to allowance together with its dependent claims, claims 2-6.

4 Applicants' program product claim, claim 7, requires at element (a) a limitation as to the  
5 prioritization scheme corresponding to the limitation described above with reference to claim 1.  
6 The independent apparatus claim, claim 14, also includes a similar limitation in element (a) of  
7 that claim. The above comments as to claim 1 therefore apply with equal force to independent  
8 claims 7 and 14. The Applicants therefore submit that claims 7 and 14 are also not obvious in  
9 view of the 308 patent and are entitled to allowance together with their respective dependent  
10 claims.

#### 11 The Dependent Claims

12 The Applicants submit also that the dependent claims include further limitations not  
13 taught or suggested by the 308 patent. The dependent claims are thus allowable both as being  
14 dependent upon an allowable base claim and for the limitations they directly add.

15 As to claims 2, 3, 8, 15, and 16, the Applicants note that there is no teaching or  
16 suggestion in the 308 patent to indicate that the optional priorities (referenced in Figure 8 and the  
17 corresponding text beginning at the bottom of Col. 11 of the 308 patent) are selectable by a user.  
18 Even if the synchronization list disclosed in the 308 patent could be considered a prioritization  
19 scheme as required in the present claims, and it clearly cannot be so considered as discussed  
20 above, the 308 patent does not suggest enabling a user to select a synchronization list from a  
21 plurality of available synchronization lists.

1 As to claims 4, 9, and 17, the Examiner cited Figure 9 of the 308 patent, reference items  
2 ST3 and ST4 as suggesting retrieving a prioritization formula based on the selected prioritization  
3 scheme and at least one sync session parameter and applying the retrieved prioritization formula  
4 to produce the prioritized data set. However, Figure 9 of the 308 patent merely illustrates the use  
5 of the synchronization list and replica list in the system disclosed in the 308 patent, and does not  
6 in any way teach or suggest any prioritization formula and certainly no such formula based on a  
7 selected prioritization scheme and at least one sync session parameter.

8 As to claims 5, 6, 10, 11, 18, 19, and 20, the Examiner cited Figures 7, 9, 10, and 11 of  
9 the 308 patent for suggesting limitations relating to the recognition of request characteristics  
10 from the sync session request (claims 5, 10, and 19) and using the recognized request  
11 characteristics to retrieve sync session parameters from storage (claims 6, 11, 18, and 20).  
12 However, the cited Figures in the 308 patent and the corresponding text do not teach or suggest  
13 any determination or recognition of any request characteristics from an incoming sync request  
14 and certainly not any characteristic client device type and communications type. Also the cited  
15 figures and corresponding text in the 308 patent do not suggest using any recognized request  
16 characteristics to retrieve sync session parameters from storage.

17 As to claims 12 and 13, the Examiner likened data specifying the synchronization lists in  
18 the 308 patent to the metadata required in claim 12 and likened the "table stored in the resource  
19 name" in the 308 patent to the objective data referenced in claim 13. However, as discussed  
20 above, the 308 patent does not teach or suggest any prioritization schemes as required by the  
21 present claims and thus cannot teach or suggest program code for collecting and storing metadata  
22 or objective data useful in effecting these prioritization schemes.

1 As to claim 21, the Examiner likened the database and data processing system in Figure 1  
2 of the 308 patent to the prioritization scheme storage arrangement required in claim 21. As  
3 discussed above, the 308 patent does not suggest the plurality of prioritization schemes required  
4 in the Applicants' claims and thus cannot suggest any storage arrangement for storing such  
5 schemes.

6  
7 The Client Device/User Language in the Claims

8 In the telephone interview Examiner Nguyen and Examiner Amsbury indicated some  
9 confusion as to the distinction between the "client device" and the "user" referenced in claim 1.  
10 The Applicants' note that the "user" is referenced separately in the claims because the  
11 prioritization schemes according to the invention may be associated with a "user" independent of  
12 any client device from which a sync session request is entered and independent of the client  
13 device to be synchronized to the objective data. Upon further review of the claim language, the  
14 Applicants' believe it is appropriate to maintain the distinction in the claims between the "client  
15 device" and the "user." It is noted that the expression "client device" is defined in the present  
16 application as "a device having data to be synchronized to data stored at another location." (Page  
17 4 of the present specification at lines 1-11).

18 In reviewing the claims, it was noted that the word "from" introducing the "client device"  
19 in claims 1 and 14 was unintentionally limiting. Thus, the above amendments modify claims 1  
20 and 14 to indicate that the sync session request designates the client device, but is not necessarily  
21 "from" the client device. The Examiner's attention is directed to the present specification at page

1 21 beginning at line 10. The text beginning at this point explains that the sync session request  
2 may in fact be initiated from a device that is not the client device to be synchronized.

3

4



## 1 CONCLUSION

2 For all of the above reasons, the Applicants respectfully request reconsideration and  
3 allowance of claims 1-22

4 If any issue remains as to the allowability of these claims, or if a conference might  
5 expedite allowance of the claims, the Examiner is asked to telephone the undersigned attorney  
6 prior to issuing a further action in this case.

7  
8 Respectfully submitted,

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10  
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## 21 CERTIFICATE OF FACSIMILE

22 I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, (Fax  
23 No. 703-872-9306) on May 25, 2004.

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